

103^D CONGRESS
2^D SESSION

S. 2341

IN THE HOUSE OF REPRESENTATIVES

OCTOBER 5, 1994

Referred to the Committee on the Judiciary

AN ACT

To amend chapter 30 of title 35, United States Code, to afford third parties an opportunity for greater participation in reexamination proceedings before the United States Patent and Trademark Office, and for other purposes.

1 *Be it enacted by the Senate and House of Representa-*
2 *tives of the United States of America in Congress assembled,*

3 **SECTION 1. SHORT TITLE.**

4 This Act may be cited as the “Patent Reexamination
5 Reform Act of 1994”.

6 **SEC. 2. DEFINITIONS.**

7 Section 100 of title 35, United States Code, is
8 amended by adding at the end thereof the following new
9 subsection:

1 “(e) The term ‘third-party requester’ means a person
2 requesting reexamination under section 302 of this title
3 who is not the patent owner.”.

4 **SEC. 3. REEXAMINATION PROCEDURES.**

5 (a) REQUEST FOR REEXAMINATION.—Section 302 of
6 title 35, United States Code, is amended to read as fol-
7 lows:

8 **“§ 302. Request for reexamination**

9 “Any person at any time may file a request for reex-
10 amination by the Office of a patent on the basis of any
11 prior art cited under the provisions of section 301 of this
12 title or on the basis of the requirements of section 112
13 of this title except for the best mode requirement. The
14 request must be in writing and must be accompanied by
15 payment of a reexamination fee established by the Com-
16 missioner of Patents and Trademarks pursuant to the pro-
17 visions of section 41 of this title. The request must set
18 forth the pertinency and manner of applying cited prior
19 art to every claim for which reexamination is requested
20 or the manner in which the patent specification or claims
21 fail to comply with the requirements of section 112 of this
22 title. Unless the requesting person is the owner of the pat-
23 ent, the Commissioner promptly will send a copy of the
24 request to the owner of record of the patent.”.

1 (b) DETERMINATION OF ISSUE BY COMMISSIONER.—

2 Section 303 of title 35, United States Code, is amended
3 to read as follows:

4 **“§ 303. Determination of issue by Commissioner**

5 “(a) Within three months following the filing of a re-
6 quest for reexamination under the provisions of section
7 302 of this title, the Commissioner will determine whether
8 a substantial new question of patentability affecting any
9 claim of the patent concerned is raised by the request,
10 with or without consideration of other patents or printed
11 publications. On his own initiative, and at any time, the
12 Commissioner may determine whether a substantial new
13 question of patentability is raised by patent or printed
14 publications or by the failure of the patent specification
15 or claims to comply with the requirements of section 112
16 of this title except for the best mode requirement.

17 “(b) A record of the Commissioner’s determination
18 under subsection (a) of this section will be placed in the
19 official file of the patent, and a copy promptly will be given
20 or mailed to the owner of record of the patent and to the
21 third-party requester, if any.

22 “(c) A determination by the Commissioner pursuant
23 to subsection (a) of this section will be final and
24 nonappealable. Upon a determination that no substantial
25 new question of patentability has been raised, the Com-

1 missioner may refund a portion of the reexamination fee
2 required under section 302 of this title.”.

3 (c) REEXAMINATION ORDER BY COMMISSIONER.—
4 Section 304 of title 35, United States Code, is amended
5 to read as follows:

6 **“§ 304. Reexamination order by Commissioner**

7 “If, in a determination made under the provisions of
8 section 303(a) of this title, the Commissioner finds that
9 a substantial new question of patentability affecting any
10 claim of a patent is raised, the determination will include
11 an order for reexamination of the patent for resolution of
12 the question. The order may be accompanied by the initial
13 Office action on the merits of the reexamination conducted
14 in accordance with section 305 of this title.”.

15 (d) CONDUCT OF REEXAMINATION PROCEEDINGS.—
16 Section 305 of title 35, United States Code, is amended
17 to read as follows:

18 **“§ 305. Conduct of reexamination proceedings**

19 “(a) Subject to subsection (b) of this section, reexam-
20 ination will be conducted according to the procedures es-
21 tablished for initial examination under the provisions of
22 sections 132 and 133 of this title. In any reexamination
23 proceeding under this chapter, the patent owner will be
24 permitted to propose any amendment to the patent and
25 a new claim or claims thereto. No proposed amended or

1 new claim enlarging the scope of the claims of the patent
2 will be permitted in a reexamination proceeding under this
3 chapter.

4 “(b)(1) This subsection shall apply to any reexamina-
5 tion proceeding in which the order for reexamination is
6 based upon a third-party reexamination request.

7 “(2) Any document (other than the reexamination re-
8 quest) filed in a reexamination proceeding by either the
9 patent owner or the third-party requester shall be served
10 on any other party.

11 “(3)(A) If the patent owner files a response to any
12 Office action on the merits, the third-party requester may
13 once file written comments within a reasonable period. At
14 a minimum, such comments may be filed within 1 month
15 after the date of service of the patent owner’s response.

16 “(B) Comments filed under this paragraph shall be
17 limited to issues covered by the Office action or the patent
18 owner’s response.

19 “(c) Unless otherwise provided by the Commissioner
20 for good cause, all reexamination proceedings under this
21 section, including any appeal to the Board of Patent Ap-
22 peals and Interferences, will be conducted with special dis-
23 patch within the Office.”.

24 (e) APPEAL.—Section 306 of title 35, United States
25 Code, is amended to read as follows:

1 **“§ 306. Appeal**

2 “(a) The patent owner involved in a reexamination
3 proceeding under this chapter may—

4 “(1) appeal under the provisions of section 134
5 of this title, and may appeal under the provisions of
6 sections 141 through 144 of this title, with respect
7 to any decision adverse to the patentability of any
8 original or proposed amended or new claim of the
9 patent; or

10 “(2) be a party to any appeal taken by a third-
11 party requester under subsection (b) of this section.

12 “(b) A third-party requester may—

13 “(1) appeal under the provisions of section 134
14 of this title, and may appeal under the provisions of
15 sections 141 through 144 of this title, with respect
16 to any final decision favorable to the patentability of
17 any original or proposed amended or new claim of
18 the patent; or

19 “(2) be a party to any appeal taken by the pat-
20 ent owner, subject to subsection (c) of this section.

21 “(c) A third-party requester who files a notice of ap-
22 peal or who participates as a party to an appeal by the
23 patent owner under the provisions of sections 141 through
24 144 of this title is estopped from later asserting, in any
25 forum, the invalidity of any claim determined to be patent-
26 able on appeal on any ground which the third-party re-

1 requester raised or could have raised during the reexamina-
2 tion proceedings. A third-party requester is deemed not
3 to have participated as a party to an appeal by the patent
4 owner unless, within twenty days after the patent owner
5 has filed notice of appeal, the third-party requester files
6 notice with the Commissioner electing to participate.”.

7 (f) REEXAMINATION PROHIBITED.—(1) Chapter 30
8 of title 35, United States Code, is amended by adding the
9 following section at the end thereof:

10 **“§ 308. Reexamination prohibited**

11 “(a) Notwithstanding any provision of this chapter,
12 once an order for reexamination of a patent has been is-
13 sued under section 304 of this title, neither the patent
14 owner nor the third-party requester, if any, nor privies of
15 either, may file a subsequent request for reexamination
16 of the patent until a reexamination certificate is issued
17 and published under section 307 of this title, unless au-
18 thorized by the Commissioner.

19 “(b) Once a final decision has been entered against
20 a party in a civil action arising in whole or in part under
21 section 1338 of title 28 that the party has not sustained
22 its burden of proving the invalidity of any patent claim
23 in suit, then neither that party nor its privies may there-
24 after request reexamination of any such patent claim on
25 the basis of issues which that party or its privies raised

1 or could have raised in such civil action, and a reexamina-
2 tion requested by that party or its privies on the basis
3 of such issues may not thereafter be maintained by the
4 Office, notwithstanding any provision of this chapter.”.

5 (2) The table of sections for chapter 30 of title 35,
6 United States Code, is amended by adding the following
7 at the end thereof:

“308. Reexamination prohibited.”.

8 **SEC. 4. CONFORMING AMENDMENTS.**

9 (a) BOARD OF PATENT APPEALS AND INTER-
10 FERENCES.—The first sentence of section 7(b) of title 35,
11 United States Code, is amended to read as follows: “The
12 Board of Patent Appeals and Interferences shall, on writ-
13 ten appeal of an applicant, or a patent owner or a third-
14 party requester in a reexamination proceeding, review ad-
15 verse decisions of examiners upon applications for patents
16 and decisions of examiners in reexamination proceedings,
17 and shall determine priority and patentability of invention
18 in interferences declared under section 135(a) of this
19 title.”.

20 (b) PATENT FEES; PATENT AND TRADEMARK
21 SEARCH SYSTEMS.—Section 41(a)(7) of title 35, United
22 States Code, is amended by inserting “or for an uninten-
23 tionally delayed response by the patent owner in a reexam-
24 ination proceeding,” after “issuing each patent,”.

1 (c) APPEAL TO THE BOARD OF PATENT APPEALS
2 AND INTERFERENCES.—Section 134 of title 35, United
3 States Code, is amended to read as follows:

4 **“§ 134. Appeal to the Board of Patent Appeals and**
5 **Interferences**

6 “(a) An applicant for a patent, any of whose claims
7 has been twice rejected, may appeal from the decision of
8 the primary examiner to the Board of Patent Appeals and
9 Interferences, having once paid the fee for such appeal.

10 “(b) A patent owner in a reexamination proceeding
11 may appeal from the final rejection of any claim by the
12 primary examiner to the Board of Patent Appeals and
13 Interferences, having once paid the fee for such appeal.

14 “(c) A third-party requester may appeal to the Board
15 of Patent Appeals and Interferences from the final deci-
16 sion of the primary examiner favorable to the patentability
17 of any original or proposed amended or new claim of a
18 patent, having once paid the fee for such appeal.”.

19 (d) APPEAL TO COURT OF APPEALS FOR THE FED-
20 ERAL CIRCUIT.—Section 141 of title 35, United States
21 Code, is amended by amending the first sentence to read
22 as follows: “An applicant, a patent owner or a third-party
23 requester, dissatisfied with the final decision in an appeal
24 to the Board of Patent Appeals and Interferences under

1 section 134 of this title, may appeal the decision to the
2 United States Court of Appeals for the Federal Circuit.”.

3 (e) PROCEEDINGS ON APPEAL.—Section 143 of title
4 35, United States Code, is amended by amending the third
5 sentence to read as follows: “In ex parte and reexamina-
6 tion cases, the Commissioner shall submit to the court in
7 writing the grounds for the decision of the Patent and
8 Trademark Office, addressing all the issues involved in the
9 appeal.”.

10 (f) CIVIL ACTION TO OBTAIN PATENT.—Section 145
11 of title 35, United States Code, is amended in the first
12 sentence by inserting “(a)” after “section 134”.

13 **SEC. 5. EFFECTIVE DATES.**

14 This Act shall take effect six months after the date
15 of enactment of this Act and shall apply to all reexamina-
16 tion requests filed on or after such date.

Passed the Senate October 4 (legislative day, Sep-
tember 12), 1994.

Attest:

MARTHA S. POPE,
Secretary.